

ARGUMENTS/REMARKS

Applicants appreciate the time that the Examiner spent during an October 28th telephone conference to discuss the claimed invention. Claims 1-22 remain in the application and reconsideration of the application is respectfully requested in light of the remarks below.

In the Office Action dated July 19, 2004, the Examiner rejected Claims 1-22 under 35 U.S.C. § 103 as being unpatentable over Raith et al. (USPN 6,498,936) in view of Sakoda et al. (USPN 6,532,223). After a careful review of Raith and Applicants' claims, it is believed that the rejection is in error and the rejection is, therefore, traversed. It is noted that the Examiner's reliance upon Raith appears to be misplaced.

In short, MPEP § 2141.03 requires that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Contrary to the Examiner's statement that Raith teaches the limitation of "operating in a first decoding mode, wherein the first decoding mode comprises a low power mode, to decode one or more sub-channels of the plurality of sub-channels, thereby yielding control information," the limitation is not disclosed (emphasis added). Thus, the rejection is unsupported by the art and should be withdrawn.

The Examiner has cited col. 9, lines 58 – col. 10, lines 17 and Fig. 3 of the Raith reference for the limitation "operating in a first decoding mode, wherein the first decoding mode comprises a low power mode, to decode one or more sub-channels of the plurality of sub-channels, thereby yielding control information," but the cited passage in Raith refers to a sleep mode where "[w]hile in sleep mode, the wireless terminal can turn off most internal circuitry and can save battery power." Raith, col. 10, lines 6-8. Unlike the wireless terminal in Raith which is turned off, the claimed invention requires decoding "*to decode one or more sub-channels.*" Specifically, the claimed invention requires "operating in a first decoding mode, wherein the first decoding mode comprises a low power mode, to decode one or more sub-channels of the plurality of sub-channels, thereby yielding control information" and such a limitation is missing from the Raith reference. Because such a limitation is missing from Raith, Raith is an inappropriate basis for rejection and Raith in combination with Sakoda is an inappropriate basis

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6

for rejection. Thus, a prima facie case for unpatentability has not been made. Since a prima facie case of unpatentability has not been made, the rejection is believed to be improper and should be withdrawn.

Accordingly, this application is believed to be in proper form for allowance and an early notice of allowance is respectfully requested.

Please charge any fees associated herewith, including extension of time fees, to **Deposit Account 502117**.

Respectfully submitted,

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7